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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Group: 1641
Confirmation No.:
Application No.: 09/848,967
Invention: IMMUNOGENIC PEPTIDES AND
USES THEREOF
Applicant: Emanuel Calenoff and Charles Ditlow
Filed: May 4, 2001
Attorney
Docket: 21417/92378
Examiner: CHEU, CHANGHWA J

} I hereby certify that this correspondence is being
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} P.O. Box 1450, Alexandria, VA 22313-1450

} on September 24, 2004

} 

} Alice O. Martin
} Registration No. 35,601

RESPONSE TO ADVISORY AND SUPPLEMENTAL ADVISORY ACTIONS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

An Advisory Action was mailed August 25, 2004 but the reasons for maintaining rejections were not clear, and no explanation was given why the amendment was "new matter" and not entered. A Supplemental Advisory Action was sent in response to applicants' request to explain why the amendment of July 16, 2004 was not entered, i.e. why was it considered "new matter". This was surprising because applicant considered the amendments were responsive to the interview of April 21, 2004.

The examiner's explanation in the Supplemental Advisory Action is provided in the left column below. Reasons why these terms were not "new" are presented by applicants in the right column:

<u>The Examiner's Quotation</u>	<u>Location that Terms Appear in the Specification</u>
"newly proposed claim 1 pose issues of scope and indefiniteness not considered in the prior Office Action For instance, With (<i>sic</i>) respect to step (d), "identical" is change of scopes similarly "matched" posing questions of definiteness, such as matched to "alignment" or "domain" or same "identical" as the comparative protein."	"identical" p. 3, lines 1-2, page 10 Fig. 2a "match" p. 2, lines 20-23, p. 5, line 16-18 "sequence matched" p. 3, lines 23-26 "identical" p. 4, steps 9-10, Fig. 2a "comparative protein", p. 3 line 1
Supplemental Advisory Action	

Also, "matching for overall homology" was in the original claims.

(claim 1)

In response to the Office Action mailed November 18, 2003 the definition of "comparative protein" was reiterated (February 18, 2004).

Applicant offers that the examiner's words are at best indefinite and do not show any reasons to call the amendment of July 16, 2004 new matter.

Also, the examiner gave no weight to a Declaration of an expert in the field of immunology, Dr. Byron Anderson, who corrected the examiner's misinterpretation of the art.

This application has been pending since May 4, 2001. Applicants have responded to one road block after another in trying to get this application issued as a patent, only to have new ones raised. These road blocks reflect not correct legal obstacles, but rather lack of understanding of the invention due to lack of understanding of immunology and inconsistent approaches. In an effort to stop these roadblocks, a Declaration from an expert in immunology, Dr. Byron Anderson was

proffered with the July 16, 2004 response. The examiner's dismissal of the Declaration in the Advisory Action indicated either he didn't read, or didn't understand Dr. Anderson's arguments. In response to Dr. Anderson's reasoned comments why Regenmortel does not anticipate the present invention, or in combination with other references, make it obvious, the examiner said the arguments are not persuasive

because mimotope is a peptide capable of inducing immunoresponse, and selection of phage peptide library is a process of "derived" or "obtained" from the target protein. (See page 334, right column, third paragraph).

It is inherent that all other known proteins besides the target protein are potential non-target protein candidates.


Advisory Action, August 25, 2004

The examiner did not, and never has, shown the presence of all elements in claim 1 in Regenmortel or any other publication. The examiner's responses are unintelligible and not legally sufficient for rejections.

If Regenmortel is removed as a reference, the Final Rejection of May 17, 2004 falls.

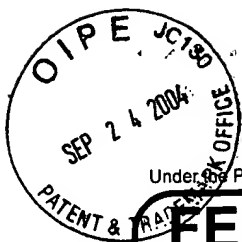
Please enter and allow the claims in the July 16, 2004 Amendment.

Respectfully submitted,


Alice O. Martin
Registration No. 35,601

Dated: September 24, 2004

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FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) \$330.00

Complete if Known

Application Number 09/848,967
Filing Date May 4, 2001
First Named Inventor Emanuel Clanoff
Examiner Name J. Fredman
Art Unit 1641
Attorney Docket No. 21417-92378

METHOD OF PAYMENT (check all that apply)

☒ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None

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Deposit Account Number 23644

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FEE CALCULATION

1. BASIC FILING FEE

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	
SUBTOTAL (1)					(\$)

2. EXTRA CLAIM FEES FOR UTILITY AND

Extra Claims		Fee from below	Fee Paid
Total Claims	-20** =		
	0	X	0.00
Independent Claims	-3** =	Fee from below	Fee Paid
	0		
		X	0.00
Multiple Dependent		Fee from below	Fee Paid

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1202	18	2202	9	Claims in excess of 20	
1201	86	2201	43	Independent claims in excess of 3	
1203	290	2203	145	Multiple dependent claim, if not paid	
1204	86	2204	43	** Reissue independent claims over original patent	
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent	

SUBTOTAL (2) (\$) \$0.00

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non - English specification	
1812	2,520	1812	2,520	For filing a request for ex parte reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	210.00
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1401	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	
1403	290	2403	145	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR § 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Statement	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	2809	385	Filing a submission after final rejection (37 CFR § 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR § 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	385.00
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify)

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$) \$595.00

SUBMITTED BY

Name (Print/Type) Alice O. Martin

Registration No. (Attorney/Agent) 35601

Complete (if applicable)

Telephone 312-214-8316

Signature

Alice O. Martin

Date

September 24, 2004

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This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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